

USSN: 09/757,175  
Atty. Docket No.: 10234/2  
Response dated August 9, 2004  
Reply to Office Action of April 9, 2004

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### REMARKS/ARGUMENTS

Claims 1, 3-5, 8-27, 29, and 31-38 are all the claims pending in the application.

Applicants note with appreciation the Examiner's indication at Section No. 3, page 2, of the Action that the §103 rejection based on Park in view of Baird has been withdrawn.

The Action contains a single rejection. At Section 4, page 2, of the Action, Claims 1, 3-5, 29, 31-36, and 38 have been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent 4,758,462 to Park, *et al.* ("Park") in view of U.S. Patent 5,443,915 to Wilkie, *et al.* ("Wilkie").

The Examiner states that Park is silent about forming an opaque core layer which is substantially free of voids. (Emphasis added.) The Examiner states that Wilkie teaches an oriented multilayer film having a white opaque skin layer. (Emphasis added.) The Examiner concludes that it would have been obvious to modify Park by reference to Wilkie motivated by the desire to obtain a substantially nonporous opaque multilayer film with improved mechanical strength.

Applicants respectfully traverse.

The claimed invention is not rendered obvious by Park in view of Wilkie because (i) even if Park is modified by reference to Wilkie, the combination does not lead to the claimed invention and (ii) the Examiner's proposed combination of Park and Wilkie is improper.

Focusing first on reason (i) above, Wilkie teaches a film structure containing a core layer and a cold seal receptive layer. Even if Applicants agreed that a person of ordinary skill in the art would modify Park by reference to Wilkie, which Applicants do not, Park's core layer would be modified by reference to Wilkie's core layer. Wilkie's core layer, however, is "transparent." Column 3, lines 40-42 and 57. Accordingly, modifying Park by reference to Wilkie would not lead to the claimed opaque core layer.

At lines 6-8 of page 3 of the Action, the Examiner states that "it is noted that Wilkie's invention is directed to an oriented multilayer film having a white-opaque skin layer (Abstract)." (Emphasis added.) In the next sentence at page 3, the Examiner states that "Wilkie teaches that

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oriented non-cavitated film layer is advantageous,” and the Examiner refers to column 4, lines 45-56, of Wilkie. Therefore, although Wilkie’s white opaque teaching is initially correctly identified as being specific to Wilkie’s skin layer, the Examiner attempts to amplify Wilkie’s skin layer teaching to a general teaching for any layer of a film. This is improper.

Wilkie’s disclosure at column 4, lines 45-56, is a specific statement particular to Wilkie’s cold seal receptive layer and is not a general statement applicable to any and all layers of a multilayer film structure. At both lines 49 and 54, Wilkie refers to the “layer of oriented film of such random copolymer” and the “oriented non-cavitated layer of this random copolymer.” (Emphasis added.) The “random copolymer” is the ethylene-propylene random copolymer of Wilkie’s cold-seal receptive layer. Thus, Wilkie’s disclosure at column 4, lines 45-56, or elsewhere, does not provide the “clear and particular” suggestion to modify Park’s core layer and arrive at the claimed opaque core layer substantially free of voids, as is required by recent Federal Circuit decisions. See, In re Sang Su Lee, 2002 U.S. App. LEXIS 855 (Fed. Cir. 2002); Winner Int’l Royalty Corp. v. Ching-Rong Wang, 53 USPQ2d 1580, 1586-1587 (Fed. Cir. 2000).

Turning to reason (ii), the Examiner’s proposed combination of Park and Wilkie is improper because a proposed modification or combination of the prior art cannot change the principle of operation of the prior art invention being modified. In re Ratti, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

Park contains multiple disclosures that make it clear that the principle of operation of Park’s invention is based on a voided core layer. Besides its Summary of the Invention and its Abstract, both of which clearly disclose the requirement of a void-containing core layer, Park at column 2, lines 53-58, discloses the importance of the core thickness, “in combination with the population and configuration of the voids.” Then, at column 4, lines 20-27, Park discloses the voids of the core (specifically, their particular dimensions) as a “**necessary part of the present invention.**” (Emphasis added.) Applicants also refer to column 3, lines 13-37.

Accordingly, modifying Park to remove its voided core layer would destroy Park’s principle of operation.

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Still further, modifying Park by reference to Wilkie is contrary to, and destroys, Park's disclosure of its core layer. The inventors of Park were specifically aware of void-free layer technology and opacifying agents, such as  $\text{TiO}_2$  pigment. Park's skin layers are disclosed as being void-free at column 2, line 12, and Park discloses the use of  $\text{TiO}_2$  pigments at columns 3 and 4, for example. Nevertheless, the Park inventors specifically chose to make their core layer a voided core layer. Therefore, it would be completely contrary to, and destroy, Park's disclosure to modify its core layer by making it void-free.


For the foregoing reasons, it is unreasonable to propose that a person of ordinary skill in the art would look to Wilkie in order to modify Park's disclosure, and Applicants respectfully request that the Examiner reconsider and withdraw the remaining §103 rejection.

The Examiner is reminded that upon the allowance of the elected claims, Claim 38 is a linking claim.

Reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

Respectfully submitted,

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